

REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-4 and 7-9 are pending in this application. Claims 5 and 6 were cancelled without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

The specification has been amended to include the abstract presented in domestic form.

No new matter has been introduced.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

The issues raised by the Examiner in the Office Action are addressed below in the order they appear in the prior Action.

II. THE OBJECTIONS TO THE DISCLOSURE ARE OVERCOME

The Examiner objects to the abstract of the disclosure because it has allegedly not been presented in the proper domestic form. The abstract is resubmitted herewith on a separate sheet for insertion into the specification after the claims. Accordingly, the objection to the disclosure is obviated.

III. THE REJECTIONS UNDER 35 U.S.C. § 103 ARE OVERCOME

Claims 1-4 and 7-9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cassayre (U.S. Patent No. 6,933,260) in view of Meinke et al. (U.S. Patent No. 5,208,222). Applicants respectfully traverse.

Establishing a *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The Examiner is respectfully reminded of the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants’ disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007).

Applying the law to the instant facts, the references relied upon by the Office Action do not disclose, suggest or enable Applicants’ invention.

As the Examiner acknowledges, Cassayre pertains to avermectin disaccharides and *not* avermectin monosaccharides, as recited in the instant claims. The Examiner contends, however, that Meinke et al. discloses interchangeability of alkylthiomono- and disaccharaide derivatives of avermectins and that one of ordinary skill in the art would have been motivated to modify the compounds disclosed by Cassayre to monosaccharide derivatives in accordance with Meinke et al. because such a person would have expected the resulting compounds to possess similar activity.

The compounds recited in the pending claims, however, are sulfamate ester monosaccharide avermectin derivatives. Meinke et al., as the Examiner acknowledges, relates to alkylthiomonosaccharide and alkylthiodisaccharide avermectin derivatives and *not* to sulfamate ester monosaccharide avermectin derivatives. In particular, the interchangeability the Examiner

alleges Meinke et al. teaches is in reference to alkylthiomono- and disaccharide derivatives in which the alkylthio group is linked via a sulfur atom to the saccharide at the 4' or 4'' position. By contrast, the compounds of the instant claims recite a sulfonamide linked via an *oxygen* atom at the 4' position of the monosaccharide avermectin derivative. As such, the references cited by the Examiner fail to recite all elements of the pending claims.

In view of the foregoing arguments, the cited references, either alone or in combination, do not render the pending claims *prima facie* obvious. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

REQUEST FOR INTERVIEW


If any issue remains as an impediment to allowance, an interview with the Examiner and SPE is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

For the reasons stated above, Applicants respectfully request a favorable reconsideration of the application, reconsideration and withdrawal of the rejections of the pending claims, and prompt issuance of a Notice of Allowance.

Respectfully submitted,
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